

AUG 29 1977

MICHAEL RODAK, JR., CLERK

In the Supreme Court of the United States

OCTOBER TERM, 19____

No. 77-155

JOHN D. BALLARD d/b/a
BALLARD'S DAIRY QUEEN,
Petitioner,

VERSUS

BURGER TRAIN SYSTEMS, INC.,
Respondent.

**RESPONSE TO PETITION FOR
WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE TENTH CIRCUIT**

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August, 1977

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STATEMENT OF THE CASE

The Petitioner herein properly stated that this appeal arises from an action commenced by the respondent, Burger Train Systems, Inc. against the Petitioner, John D. Ballard, d/b/a Ballard's Dairy Queen, seeking an injunction and damages as a result of an infringement of patents owned by the respondent. Judgment was entered in favor of the respondent as to the utility patent. The Court of Appeals for the Tenth Circuit affirmed the Court below, and it is from that action that the Petitioner is seeking relief.

The Petitioner improperly stated that the Court of Appeals failed to respond to Petitioner's argument with respect to the question presented herein relative to the

effect of the combination of claims in a patent operating on the doctrine of equivalents. It is the position of the respondent herein that the Tenth Circuit below properly responded to Petitioner's arguments and properly affirmed the judgment of the Court below.

REASONS FOR DENYING THE WRIT

The Petitioner is, of course, required, pursuant to Rule 19 of the Supreme Court Rules, to establish an appropriate reason for this Court to grant the writ in question. Petitioner's sole basis for his claim to entitlement to a writ is his allegation that the Court of Appeals rendered a decision in conflict with its previous decisions and in conflict with applicable decisions of this Court.

The Petitioner's sole basis for asserting this position is Petitioner's misconception of the law previously adduced by this Court to the view that in all cases the doctrine of file wrapper estoppel necessarily prevents the operation of the doctrine of equivalents to any degree. To state that this Court has totally foreclosed the operation of the doctrine of equivalents any time there is a narrowing of a claim brought about by the patent office is, in the respondent's view, a misstatement of the law previously adduced by this Court.

The law adduced by this Court with reference to the narrowing of claims can be found in the case of *Graham v. John Deere Company*, 383 U.S. 1, 33 (1966), of which the Court stated in its pertinent part that:

"Claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art

cannot be sustained to cover that which was previously eliminated from the patent."

This Court, then, has properly held a patentee may not recapture that which he has given up at the patent office in order to have his patent accepted. The Court of Appeals below properly recognized the law this Court has applied in the *Graham* case (see page A-11 of the Petitioner's Appendix), wherein the *Graham* case is cited in the Court's opinion. The Court's position, as disclosed at page A-12 of the Petitioner's Petition, was that the doctrine of file wrapper estoppel only precludes one from recapturing what he has given up or waived in the application for patent process and not that the application of that doctrine totally eliminates the application of the doctrine of equivalents.

The Court recognized that the ultimate issue is not whether the doctrine of file wrapper estoppel should apply, but rather "whether the patent holder gave up the features or elements which characterized the accused structure." (See page A-12 of Petitioner's Petition.)

It should be seen, then, from a reading of the Tenth Circuit's opinion that the Court at no time advanced a position at odds with any previous decision of this Court since this Court has never gone so far as to suggest that a patentee, by accepting an amendment, should ever give up more than what the amendment required him to do. It is clear that the Tenth Circuit recognized the principle of the doctrine of file wrapper estoppel and its limiting effect upon the application of the doctrine of equivalents, but nonetheless, determined that the respondent's claims were not that far limited and, therefore, that the jury's verdict

should not be set aside in its determination that the Petitioner's device infringed the patent held by the respondent.

It is apparent that consistent with Rule 19 of this Court's rules there is no reason for this Court to accept jurisdiction for the review of the Tenth Circuit's decision. In the trial of the case at bar, the Petitioner herein was protected in the position he asserts even more so by reason of the instruction the Trial Court gave the jury with reference to the doctrine of file wrapper estoppel. See page 119 of the original record, wherein instruction number 10 of the Court instructed the jury as follows: "You are further instructed however that the amended claims in the patent cannot be construed to cover the invention defined in the claims as originally filed."

It should, therefore, be seen that the jury necessarily must have concluded that the respondent herein was not attempting to recapture his original claim by his allegation of infringement, but rather relied entirely upon his claim as amended.

The Tenth Circuit found (see page A-14 of Petitioner's Petition) that the effect of the proceedings before the patent office was to consolidate four claims into a single claim and thus bring about a combination patent containing several means. The Court, therefore, concluded that the doctrine of equivalents was properly submitted before the jury and that its verdict based thereon was proper.

It is submitted by your respondent that in all cases in which one seeking a patent is obliged to make some amendment to his patent, it is important that to some extent the patentee be able to apply the doctrine of equivalents. It is

apparent that anyone seeking to infringe the patent of another can make some small minor change not important to the function or operation of the device, but sufficient to avoid the literal claim of the patent so that without the operation of the doctrine of equivalents he would be able to infringe freely. In no case of patent infringement is ever found a Chinese copy. It is, therefore, very important that to a limited degree the doctrine of equivalents apply even though some amendment is made at the patent office.

CONCLUSION

For the foregoing reasons, it is submitted that this Court should refuse to consider Petitioner's Writ for Certiorari.

Respectfully submitted,

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August, 1977

CERTIFICATE OF SERVICE

I hereby certify that three (3) true and correct copies of the foregoing RESPONSE TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT was mailed, first class, postage prepaid to Jerry J. Dunlap, DUNLAP, CODDING & McCARTHY, 510 Fidelity Plaza, Oklahoma City, Oklahoma 73102 on this day of, 1977.

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Robert B. Smith